Supreme Court, U.S.
FILED
DEC 17 1986
JOSEPH F. SPANIOL, JR.
CLERK

No. 86- 1004

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1986

TECHNOGRAPH LIQUIDATING TRUST,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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Questions Presented

1. Did the Federal Circuit commit reversible error of law in transferring the appeal to the Third Circuit in light of the statute (28 U.S.C. sec. 1295(a)(1)) which provides that the "United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction of an appeal . . . if the jurisdiction of [the district] court was based on section 1338 of this title (the Patent Code)" where the jurisdiction of the district court indisputably arose under the Patent Code with the appeal involving a substantial patent question; namely, a reasonable royalty for patent infringement (35 U.S.C. sec. 284)?

2. May one court of appeals transfer an appeal to another court of appeals pursuant to 28 U.S.C. sec. 1631 ("transfer to cure want of jurisdiction") on account of "interests of comity and judicial economy" without making a finding that there is a want of jurisdiction in the transferring court?

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* The only petitioner in this case is Technograph Liquidating Trust, successor to Technograph, Inc., a North Carolina Corporation. The other named plaintiffs below—Devex Corporation, William C. McCoy, Jr., individually and as an Executor of the Estate of William C. McCoy, deceased, Theodore A. TeGrotenhuis, Frederick B. Ziesenheim, Marjorie TeGrotenhuis, and Katherine M. Bassett—no longer have any interest in the litigation.

The Respondent is General Motors Corp., a Delaware Corporation.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1986

TECHNOGRAPH LIQUIDATING TRUST,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Opinions Below

The Judgment and Order of the Court of Appeals for the Federal Circuit dated August 22, 1986 are not reported. (1a-2a).[1] The Opinion of the District Court is not reported. (7a).

Jurisdiction

The Judgment of the Court of Appeals was entered on August 22, 1986 (1a). A timely petition for rehearing was denied on September 18, 1986 (4a), and this petition for a Writ of Certiorari was filed within 90 days of that date.[2] The jurisdiction of this Court is invoked under 28 U.S.C. sec. 1254(1). The history of this litigation confirms the continued presence of patent issues in this lawsuit.[3]

[1] Citations to the Appendix at the rear of this petition are designated by page number and "a". Emphasis is supplied throughout unless otherwise noted.

[2] A suggestion for rehearing *en banc* was declined on September 30, 1986. (5a).

[3] *See Devex Corp. v. General Motors Corp.*, 321 F.2d 234 (7th Cir. 1963) (patent validity); *Devex Corp. v. General Motors Corp.*, 467 F.2d 257 (3d Cir. 1972), *cert. denied*, 411 U.S. 973

(footnote continued on following page)

Statutes Involved

Question one involves the Federal Courts Improvement Act of 1982, 28 U.S.C. sec. 1295(a)(1), which provides:

> The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—
> (1) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, except that a case involving a claim arising under any Act of Congress relating to copyrights or trademarks and no other claims under section 1338(a) shall be governed by sections 1291, 1292, and 1294 of this title;

28 U.S.C. sec. 1295(a)(1). 28 U.S.C. sec. 1338 is the jurisdictional statute covering civil actions arising under the patent laws.

Question two involves 28 U.S.C. sec. 1631, captioned "transfer to cure want of jurisdiction," which provides:

> Whenever a civil action is filed in a court as defined in section 610 of this title or an appeal, including a petition for review of administrative

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(footnote continued from preceding page)

(1973) (patent infringement); *Devex Corp. v. General Motors Corp.*, 667 F.2d 347 (3d Cir. 1981) (reasonable royalty and pre-judgment interest under sec. 284 of the patent code), *cert. denied in part and granted in part*, 456 U.S. 988 (1982); *General Motors Corp. v. Devex Corp.*, 461 U.S. 648 (1983) (pre-judgment interest under sec. 284 of the patent code); *Devex Corp. v. General Motors Corp.*, 749 F.2d 1020 (3d Cir. 1984) (post-judgment interest, no patent question on appeal) *cert. denied*, 106 S.Ct. 68 (1985).

> action, is noticed for or filed with such a court *and that court finds that there is a want of jurisdiction,* the court shall, if it is in the interest of justice, transfer such action or appeal to any other such court in which the action or appeal could have been brought at the time it was filed or noticed, and the action or appeal shall proceed as if it had been filed in or noticed for the court to which it is transferred on the date upon which it was actually filed in or noticed for the court from which it is transferred.

28 U.S.C. sec. 1631.

The complaint and appeal also involve 35 U.S.C. sec. 284 which provides:

> Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

35 U.S.C. sec. 284.

Statement of the Case

The basis for federal jurisdiction in the United States District Court is the patent laws of the United States. 28 U.S.C. sec. 1338. The very first paragraph of the complaint states the jurisdictional predicate (18a):

> This is a civil action for patent infringement. The jurisdiction of the Court in this action arises under the Patent Laws of the United States.

This action for patent infringement was commenced in 1956. The patent covers a lubricating process used in cold forming metal car parts by pressure. In 1963, Claim 4, the only claim of the patent involved, was held valid. *Devex Corp. v. General Motors Corp.*, 321 F.2d 234 (7th Cir.

1963) *cert. denied,* 375 U.S. 971 (1964). It is also settled that Claim 4 was infringed by General Motors Corp. in the production of bumper and non-bumper (cold extruded) parts. *Devex Corp. v. General Motors Corp.,* 467 F.2d 257 (3d Cir. 1972) *cert. denied,* 411 U.S. 973 (1973).

This case was here at an earlier stage: this Court decided that prejudgment interest should ordinarily be granted on a reasonable royalty award for patent infringement in the manufacture of bumpers, "to insure that the patent owner is placed in as good a position as he would have been in had the infringer entered into a reasonable royalty agreement." *General Motors Corp. v. Devex Corp.,* 461 U.S. 648, 655 (1983). The Opinion of the Court recites the earlier litigation history.

In 1984, the Third Circuit heard a later appeal in this case involving only the award of post-judgment interest. *Devex Corp. v. General Motors Corp.,* 749 F.2d 1020 (3d Cir. 1984). There were no patent law issues involved in that appeal. This Court denied certiorari on the post-judgment interest issue and on the issue of failure to award any royalty whatsoever on non-bumper parts found to be an infringement. 106 S.Ct. 68 (1985).

The pertinent starting point for the present phase is the final order of June 27, 1986 issued by the District Court. That judgment denied plaintiff's motion (1) to reconsider the refusal to award any royalty whatsoever after finding infringement of 1.3 billion non-bumper parts and (2) to award interest on the amount stated in a final order pending General Motors' unsuccessful appeal.

Plaintiff appealed to the Federal Circuit. The appeal raised two questions of law. The first question involved the proper interpretation of a section of the patent laws, 35 U.S.C. sec. 284 to wit:

> In light of (i) intervening authority in the Federal Circuit, which authority is controlling on ques-

> tions of patent law and/or (ii) the manifest injustice of the prior result, is plaintiff now entitled to a reasonable royalty for GM's massive infringement of 1.3 billion non-bumper parts, notwithstanding an earlier decision of the Third Circuit affirming the refusal to award any royalty whatsoever?

The second question involved a post-judgment interest question.

Defendant moved to transfer the appeal to the Third Circuit. By order dated August 22, 1986, the Federal Circuit granted the motion based on the prior history of the litigation (2a-3a).

Petitioner, contending that the Third Circuit lacked subject matter jurisdiction to hear the instant patent appeal, filed a motion in the Third Circuit to transfer back to the Federal Circuit. By order dated December 11, 1986, that motion was denied (6a). Plaintiff intends to file a petition for writ of certiorari from that order.

REASONS FOR GRANTING THE WRIT

This Court should review the decision of the Federal Circuit transferring the appeal to the Third Circuit because that order is in direct contravention with the express statutory grant of exclusive subject matter jurisdiction to the Federal Circuit in 28 U.S.C. sec. 1295(a)(1), and the issue is one of extraordinary public importance since it involves the interpretation of the statute which created the Court of Appeals for the Federal Circuit to develop uniformity in the substantive law of patents and, toward that end, granted the Federal Circuit exclusive jurisdiction.

1. Since 28 U.S.C. sec. 1295 vests "*exclusive jurisdiction*" of this patent appeal in the Federal Circuit, that Court was not free to ignore that mandate because of comity, judicial economy and familiarity of another court.

The transfer order in this case plainly disregards the express statutory grant of exclusive subject matter jurisdiction of the Federal Circuit over patent appeals. In *haec verba* the statute provides for "*exclusive jurisdiction* of an appeal" if the jurisdiction of the district "court was based, in whole or in part, on sec. 1338 of this title." 28 U.S.C. sec. 1295(a)(1).

The Federal Circuit's transfer order simply ignores the express mandate of the statute as it focuses on the prior history of this litigation in the Third Circuit:

> The Third Circuit has developed a familiarity with this case extending over some fourteen years. The interests of comity and judicial economy are best served by a transfer to that court.

(3a). Contrary to the Federal Circuit decision, the conclusion is inescapable that familiarity in one court cannot oust exclusive jurisdiction from another.

The plain language of the statute conclusively establishes that as an initial matter, the jurisdiction of the Federal Circuit is defined in terms of the jurisdiciton of the District Court arising under the patent laws. *Atari, Inc. v. JS&A Group, Inc.*, 747 F.2d 1422, 1433 (Fed. Cir. 1984). Measured by that standard, there is no question that this appeal belongs in the Federal Circuit because it arises under the patent laws. The complaint and the history of this litigation confirm that this has been and continues to be a patent case. (*supra*, Jurisdiction).

The statute, however, has also been interpreted to require a "present or potential patent issue" on appeal if exclusive jurisdiction is to vest in the Federal Circuit. *USM Corp. v. SPS Technologies, Inc.*, 770 F.2d 1035, 1037 (Fed. Cir. 1985).[4] Measured by this standard also, the subject appeal undoubtedly belongs in the Federal Circuit. Plaintiff raised a substantial patent question below and on appeal. In its transfer order, the Federal Circuit itself noted plaintiff's assertion of a patent damages claim, but then erroneously transferred the appeal rather than proceed to the merits.

Significantly, the parties' dispute regarding the contours of the "law of the case" doctrine in the context of a patent case is itself a patent question. In *Central Soya Co., Inc. v. Geo A. Hormel & Co.*, 723 F.2d 1573 (Fed. Cir. 1983), the

[4] Where an appeal is "wholly devoid of issues under sec. 1338, present or potential," notwithstanding the fact that jurisdiction in the District Court was based in whole or in part on sec. 1338, the Federal Circuit has generally concluded that it does not have jurisdiction. *USM Corp.*, 770 F.2d at 1037. *But see Albert v. Kevex Corp.*, 729 F.2d 757 (Fed. Cir. 1984) (exclusive jurisdiction in Federal Circuit on appeal from summary judgment involving antitrust claim only, where two patent infringement counts remanied to be adjudicated in district court).

Federal Circuit sat as successor to the Tenth Circuit which had decided certain patent questions in the case prior to the creation of the Federal Circuit. With regard to the Tenth Circuit's determination of liability, the Federal Circuit recognized that (1) it might be reopened under exceptions to the law of the case doctrine, and (2) the Federal Circuit, not the Tenth Circuit, was the proper court to consider those exceptions.

2. Neither the prior decisions by the Third Circuit nor the added presence of a non-patent law question on appeal can divest the Federal Circuit of the exclusive jurisdiction mandated by the statute.

In transferring the appeal to the Third Circuit because of that court's earlier involvement with this litigation, the Federal Circuit ignored the mandatory grant of exclusive jurisdiction to the Federal Circuit for patent appeals filed after October 1, 1982, the effective date of the Federal Courts Improvement Act of 1982, Pub. L. 97-164, Title I, sec. 127(a). Notwithstanding prior appeals to the regional circuit courts, the Federal Circuit now has exclusive jurisdiction of appeals involving patent issues. *Central Soya Co. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1580 (Fed. Cir. 1983); *Stewart-Warner Corp. v. City of Pontiac Michigan*, 767 F.2d 1563, 1568 (Fed. Cir. 1985).

Finally, the fact that an appeal also raised a non-patent question does not affect appealability to the Federal Circuit. "Non-patent issues in the suit, even if they have their genesis in federal law, are for the purposes of establishing appellate jurisdiction considered pendent to the patent claims." *Christianson v. Colt Industries Operating Corp.*, 798 F.2d 1051, 1058 (7th Cir. 1986) (citations and footnote omitted). In furtherance of the congressional intent to avoid bifurcation of appeals, the Federal Circuit has pendent jurisdiction of the non-patent issues on appeal. *See Atari, Inc. v. JS&A Group, Inc.*, 747 F.2d 1422, 1435 (Fed. Cir. 1984); *Albert v. Kevex Corp.*, 729 F.2d 757 (Fed. Cir. 1984).

3. This Court should define the jurisdiction of the Federal Circuit in accord with the clear statutory language and the legislative history in order to avoid the unseemly and costly "ping pong" between the Federal Circuit and the regional circuit courts in patent matters.

This Court should grant the writ of certiorari in order to clarify the jurisdiction of the Federal Circuit Court of Appeals. 28 U.S.C. sec. 1295(a)(1) gives that court "exclusive jurisdiction." If "exclusive" jurisdiction means exclusive, than other courts cannot possibly have concurrent jurisdiction over the very same appeals. Further, if the grant of jurisdiction is mandatory, then courts are not at liberty to exercise their discretion and transfer an appeal elsewhere.

Since the effective date of the Federal Circuit in October 1982, the courts have been bombarded with a plethora of cases involving jurisdictional disputes between the Federal Circuit and the regional circuit courts of appeal. The uncertainty has resulted in the forum-shopping that the Federal Circuit was specifically designed to prevent. In *Christianson v. Colt Industries Operating Corp.*, 798 F.2d 1051 (7th Cir. 1986), the Seventh Circuit emphasized the "considerable expense to the parties and the judicial system" caused by the jurisdictional uncertainty created by section 1295. The *Christianson* appeal (as this appeal)

> is but another in the burgeoning list of cases delineating, at considerable expense to the parties and the judicial system and no doubt considerable bewilderment to laymen, the boundaries of 28 U.S.C. sec. 1295(a)(1).

798 F.2d at 1058 n. 10. In *Christianson,* the Federal Circuit had transferred the appeal to the Seventh Circuit. The Seventh Circuit disagreed with the transfer order, found that the case arose under the patent laws, and transferred back to the Federal Circuit under 28 U.S.C. sec. 1631.

Recently, at oral argument before the Federal Circuit, the jurisdictional issue was again raised.

Petitioner respectfully submits that the transfer order from the Federal Circuit in this case was in clear conflict with the statutory mandate which looks to the jurisdiction of the district court as an initial matter, and with the judicial gloss that has required a patent issue on appeal. Petitioner's appeal satisfied both requirements. Indeed, the transfer order does not even suggest otherwise.

In any event, petitioner respectfully submits that the current uncertainty regarding the jurisdictional parameters of the Federal Circuit has resulted in costly and unseemly litigation not envisioned by Congress. The congressional objective of development of a uniform body of substantive patent law has been seriously thwarted. In its place, the Federal Circuit and the regional courts of appeals are embroiled in endless disputes regarding the jurisdiction of appeals in patent cases. Thus, this petition presents a question of extraordinary public importance as it urges this Court to clarify the jurisdiction of the Federal Circuit.

This Court should review the transfer order of the Federal Circuit under 28 U.S.C. sec. 1631 (transfer to cure want of jurisdiction) because that order, which was based on familiarity, comity, and judicial economy, disregards the plain language of the statute requiring a finding of a want of jurisdiction.

The statute authorizing the transfer of civil actions and appeals on jurisdictional grounds requires that the transferring court make an explicit finding "that there is a want of jurisdiction" before it transfers an appeal. 28 U.S.C. sec. 1631. *Hempstead Cty. and Nevada Cty. Project v. Environmental Protection Agency,* 700 F.2d 459, 462 (8th Cir. 1983).

The transfer order of the Federal Circuit flatly ignores the requirements of the statute. There is absolutely no

suggestion that there is a want of jurisdiction. Rather, the order is explicitly premised on concerns not mentioned in sec. 1631:

> The Third Circuit has developed a familiarity with this case extending over some fourteen years. The interests of comity and judicial economy are best served by a transfer to that court.

(3a).

CONCLUSION

For the foregoing reasons, the Petition for Writ of Certiorari should be granted.

Respectfully submitted,

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December 17, 1986

Appendix A

United States Court of Appeals for the Federal Circuit

DEVEX CORPORATION, ET AL.,
Plaintiff-Appellant,

vs.

GENERAL MOTORS CORPORATION,
Defendant-Appellee.

No. 86-1523

Judgment

ON APPEAL from the UNITED STATES DISTRICT COURT OF DELAWARE **IN CASE NO(S).** CA 3058

This CAUSE having been heard and considered, it is ORDERED AND ADJUDGED:

TRANSFERRED PURSUANT TO 28 U.S.C. SECTION 1631 TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

Dated August 22, 1986

ENTERED BY ORDER OF THE COURT

/s/ Francis X. Gindhart
FRANCIS X. GINDHART, CLERK

ISSUED AS A MANDATE: September 25, 1986

Appendix B

Note: This Order will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals
for the Federal Circuit

DEVEX CORPORATION, et al.,

Appellants,

v.

GENERAL MOTORS CORPORATION,

Appellee.

Appeal No. 86-1523
ON MOTION

Before MARKEY, *Chief Judge,* NEWMAN and BISSELL, *Circuit Judges.*

ORDER

Appellee General Motors Corporation (GM) moves for an order transferring the appeal noticed by appellant Devex Corporation (Devex) to the U.S. Court of Appeals for the Third Circuit. GM argues that the only issue on appeal concerns interest on the postjudgment interest judgment and interest on the cost judgment and is more appropriately heard by the Third Circuit.[1]

Devex opposes the motion to transfer on the ground that, in addition to the interest issue, the appeal concerns a patent damages issue. GM argues that the damages issue

[1] For a history of this litigation, *see Devex Corp. v. General Motors Corp.*, 467 F.2d 257 (3d Cir. 1972), *cert. denied*, 411 U.S. 973 (1973); *Devex Corp. v. General Motors Corp.*, 667 F.2d 347 (3d Cir. 1981), *cert. denied in part*, 456 U.S. 988 (1982), *cert. granted in part, General Motors Corp. v. Devex Corp.*, 461 U.S. 648 (1983); *Devex Corp. v. General Motors Corp.*, 749 F.2d 1020 (3d Cir. 1984), *cert. denied*, 54 U.S.L.W. 3223 (1985).

is a red herring and that Devex is trying, once again, to reopen a damages issue that was decided by the Third Circuit in its 1981 decision.[2]

On March 20, 1984 this court dismissed cross-appeals in this litigation on postjudgment interest issues because the Third Circuit had asserted jurisdiction. This case began in the Third Circuit, which issued two decisions in the case well before this court was created. In 1984 it issued a third decision in the case. The parties' arguments over the presence or absence of particular "issues" remaining are unpersuasive in this case. *See Atari, Inc. v. JS&A Group, Inc.*, 747 F.2d 1422, 1429 (Fed. Cir. 1984) (*in banc*). The Third Circuit has developed a familiarity with this case extending over some fourteen years. The interests of comity and judicial economy are best served by a transfer to that court. *See USM Corporation v. SPS Technologies, Inc.*, 770 F.2d 1035, 1037 (Fed. Cir. 1985); *Atari, supra.*

Accordingly,

IT IS ORDERED THAT:

The appeal is transferred pursuant to 28 U.S.C. § 1631 to the Court of Appeals for the Third Circuit.

22 Aug 86
Date

FOR THE COURT

/s/ Howard T. Markey
Howard T. Markey
Chief Judge

cc: Sidney Bender, Esq.
Arthur G. Connolly, Jr., Esq.

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[2] Certiorari was denied on this issue by the Supreme Court, 456 U.S. 988 (1982). A "Motion for Leave to File Out-of-Time Petition for Rehearing" on the damages issue was also denied by the Supreme Court, 54 U.S.L.W. 3228 (October 7, 1985).

Appendix C

United States Court of Appeals for the Federal Circuit

DEVEX CORPORATION, ET AL.,D,

Appellant,

vs.

GENERAL MOTORS CORPORATION,

Appellee.

Appeal No. 86-1523

Before MARKEY, *Chief Circuit Judge,* NEWMAN and BISSELL, *Circuit Judges.*

ORDER

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

FOR THE COURT

/s/ Francis X. Gindhart

Francis X. Gindhart, Clerk

9/18/86

Date

cc: Mr. Sidney Bender
Mr. Arthur G. Connolly, Jr.

Appendix D

United States Court of Appeals for the Federal Circuit

DEVEX CORPORATION, ET AL.,

Appellant,

vs.

GENERAL MOTORS CORPORATION,

Appellee.

Appeal No. 86-1523

ORDER

A suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the suggestion for rehearing in banc is declined.

FOR THE COURT

/s/ Francis X. Gindhart

Francis X. Gindhart, Clerk

9/30/86

Date

cc: Mr. Sidney Bender
Mr. Arthur G. Connolly, Jr.

Appendix E

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 86-5771 November 28, 1986
DEVEX CORP., et al.

vs.

GENERAL MOTORS CORP.
Devex Copr., et al., Appellants
(DE D.C. Civil No. 3058)

Present: GIBBONS, STAPLETON and MANSMANN,
Circuit Judges.

1. Appellants' motion to transfer appeal to the U.S. Court of Appeals for the Federal Circuit,
2. Appellee's memorandum opposing motion to transfer appeal to the Federal Circuit,
3. Appellants' reply memorandum in support of motion to transfer, (Due 11-24-86, received on 11-28-86, not filed unless Court directs)

in the above-entitled case.

Respectfully,

/s/ Marta Sanchez
Deputy Clerk
597-3080

The foregoing motion is/~~are~~ *denied.*

By the Court.

/s/ John J. Gibbons
Judge

Dated: December 11, 1986 dt/cc: AWP, Jr.
SB
AGC

Appendix F

IN THE UNITED STATES COURT DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

DEVEX CORPORATION, et al.,
Plaintiffs,
v. Civil Action 3058 CMW

GENERAL MOTORS CORPORATION,
Defendant.

CONSOLIDATED

FREDERICK B. ZIESENHEIM, et al.,
Plaintiffs,
v. Civil Action 83-567 CMW

TECHNOGRAPH, INC.,
Defendant.

Robert K. Payson, Esquire of Potter, Anderson & Corroon, Wilmington, Delaware.
OF COUNSEL: Sidney Bender, Esquire, Aaron Lewittes, Esquire and Janine L. Bender, Esquire of Leventritt, Lewittes & Bender, Garden City, New York
Attorneys for Defendant, Technograph, Inc., in Civil Action 83-567.

Arthur G. Connolly, Esquire and Arthur G. Connolly, Jr., Esquire of Connolly, Bove, Lodge & Hutz, Wilmington, Delaware.
OF COUNSEL: William A. Schuetz, Esquire of Detroit, Michigan; George E. Frost, Esquire of Barnes, Kisselle, Raisch, Choate, Whittemore & Hulbert, Birmingham, Michigan.
Attorneys for Defendant, General Motors Corporation in Civil Action 3058.

OPINION

Wilmington, Delaware
June 27, 1986

Appendix F

WRIGHT, Senior Judge:

This patent litigation has been before this Court for more than twenty years, has generated numerous opinions and appeals, and threatens to outlast all human participants. Currently pending is the motion of plaintiff Technograph, Inc., for a reasonable royalty and prejudgment interest in relation to previously determined infringement for non-bumper parts, and for additional interest on an award of postjudgment interest previously granted by this Court.

The Court will not set out the protracted history of this dispute because it has been reported extensively, *see, e.g.*, 494 F.Supp. 1369 (D.Del. 1980); 569 F.Supp. 1354 (D.Del. 1983), *aff'd* 749 F.2d 1020 (3d Cir. 1984), and because the current motion focuses on two limited issues. The Court instead will relate separately the relevant background on each prong of plaintiff's motion.

I. REASONABLE ROYALTY AWARD

The patent at issue here involved a process for cold-forming steel products, which defendant General Motors Corp. ("G.M.") used to produce both bumper and non-bumper parts. Following a finding of infringement, *see* 467 F.2d 257 (3d Cir. 1972), an accounting of damages was conducted before a Special Master. The Master awarded substantial damages for bumper part infringement, but concluded that the proof was too speculative to allow an award of damages for non-bumper part infringement. This Court approved the Master's Findings and Conclusions on non-bumper damages, *see* 494 F.Supp. 1369, 1377-78 (D.Del. 1980).

The Third Circuit affirmed the decision not to award damages for non-bumper parts, finding that plaintiff had failed to provide credible evidence from which a reasonable royalty for infringement could be calculated. 667 F.2d 347,

362 (3d Cir. 1981). Plaintiff filed a petition for certiorari with the U.S. Supreme Court, arguing that the failure to award damages after a finding of infringement in the production of non-bumper parts violated the mandate of 35 U.S.C. § 284.[1] The Supreme Court denied *cert.*, *see* 456 U.S. 990 (1982). The Court did consider G.M.'s petition on the issue of prejudgment interest on the damages award for bumper-part infringement and affirmed the award. 461 U.S. 648 (1983).

After this Court's rulings on postjudgment interest and interests on costs were affirmed by the Third Circuit, *see* 749 F.2d 1020 (1984), plaintiff filed a petition for certiorari on the postjudgment interest issue which also raised the issue of a damages award for non-bumper parts infringement. The basis for this petition was the alleged conflict between the Third Circuit's 1981 ruling in this case and decisions of the Federal Circuit rendered in 1983. *See* 53 U.S.L.W. 3839 (U.S. May 13, 1985) (No. 84-1795). The Supreme Court again denied the petition. *See* 54 U.S.L.W. 3223 (U.S. Oct. 7, 1985).

Plaintiff's argument here appears similar to that made to the Supreme Court in the second *cert.* petition: namely, that a conflict exists between the 1981 Third Circuit decision refusing to grant a royalty award for non-bumper part infringement and later decisions of the Federal Circuit.[2] Plaintiff argues that this Court still retains juris-

[1] This section states: "Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, . . . "

[2] Those cases are *Stickle v. Heublein, Inc.*, 716 F.2d 1550 (Fed.Cir. 1983); *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075 (Fed.Cir. 1983); and *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506 (Fed.Cir. 1984); *see also, Armco, Inc. v. Republic Steel Corp.*, 707 F.2d 886 (6th Cir. 1983). Plaintiff

(*footnote continued on following page*)

diction over this case and this issue, despite the previous appeals, and that the Court has the power under the law of the case doctrine to recognize the supervening change of law and "correct" the Third Circuit's mistake.

For the sake of argument, the Court will assume that the first two steps of plaintiff's reasoning are correct: the 1981 Third Circuit decision conflicts with later appellate decisions, and this Court retains jurisdiction to reopen the question of a royalty award for infringement in the production of non-bumper parts.[3] Nevertheless, the Court cannot grant plaintiff's request and act on the supervening change of law under the law of the case doctrine.

As a general matter, a court can reconsider a previous ruling when a supervening decision has changed the applicable rule of law. *See, e.g., Zichy v. City of Philadelphia*, 590 F.2d 503, 508 (3d Cir. 1979); *Al Haddad Bros.*

(*footnote continued from preceding page*)
interprets those cases as requiring a court always to award at least a reasonable royalty and prohibiting the denial of any award where the court finds infringement of a valid patent.

[3] The Court has serious doubts about both of these assumptions. Regarding the alleged conflict between the Third Circuit and Federal Circuit decisions, this Court notes the Federal Circuit's recent statement on proof of damages: "One who fails to submit evidence in support of a position cannot be heard on appeal to complain that the trial court failed to find facts upholding that position." *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1519 (Fed.Cir. 1984). In addition, plaintiff's reliance on G.M.'s supposed concession in its latest Supreme Court brief that "*Stickle* is now controlling" is simply beside the point. Plaintiff has taken this statement out of context.

Regarding the Court's continuing jurisdiction over this issue, it appears that a matter which has been decided by the district court, affirmed by the Court of Appeals, and denied certiorari by the Supreme Court generally is no longer *sub judice* in the district court. *See Seese v. Volkswagenwerk, A.G.*, 679 F.2d 336, 337 (3d Cir. 1982) (motion under Fed.R.Civ.P. 60(b)(6)); *Eutectic Corp. v. Metco, Inc.*, 597 F.2d 32, 34 (2d Cir. 1979) (same).

Enterprises, Inc. v. M/S Agapi, No. 82-92, slip op. at 5 (D.Del. May 8, 1986). However, a trial court's power to reconsider a question is very limited after the appeals court has issued a mandate on the question and the matter is again before the trial court on remand or other subsequent proceedings. The proper course for plaintiff to follow if it believes that subsequent decisions have cast doubt on the correctness of the Third Circuit's 1981 ruling on non-bumper parts is to apply to the Third Circuit for a modification or recall of its mandate. *See Riley v. MEBA Pension Trust,* 586 F.2d 968, 972 (2d Cir. 1978); *Elias v. Ford Motor Co.,* 734 F.2d 463, 465-66 (1st Cir. 1984); IB J.Moore, Moore's Federal Practice ¶ 404[10], at 171-172 (2d ed. 1984). This Court's acceptance of plaintiff's invitation to "reverse" the Third Circuit surely would invite a later reversal from that court.[4]

In addition to its "law of the case argument", Technograph claims that its motion on the non-bumper parts issue is proper under Fed.R.Civ.P. 60(b)(6). This provision allows a court to relieve a party from a final judgment or order for "any other reason justifying relief from the operation of the judgment." In *Seese v. Volkwagenwerk, A.G.,* 679 F.2d 336 (3d Cir. 1982), the district court had denied a rule 60(b)(6) motion seeking relief from the Third

[4] In *Morrow v. Dillard,* 580 F.2d 1284, 1297 (5th Cir. 1978), the circuit court found that the district court properly reconsidered its grant of attorneys' fees on remand because of an intervening Supreme Court decision on the question. *Morrow* is distinguishable for two reasons. The original Fifth Circuit decision in *Morrow* did not directly address the attorneys' fee issue, whereas the Third Circuit did address directly the non-bumper parts royalty issue. Second, the intervening decision in *Morrow* came from the Supreme Court and directly conflicted with prior law. In contrast, here the intervening decisions came from a court coordinate to the Third Circuit and may not conflict with the Third Circuit decision, *see supra* note 3.

Circuit mandate in thie case because of a subsequent holding by the Fourth Circuit in direct opposition to the Third Circuit's original decision. The Third Circuit had denied rehearing after the Fourth Circuit decision, and the Supreme Court denied certiorari. The Third Circuit affirmed denial of the Rule 60(b)(6) motion: "The district court is without jurisdiction to alter the mandate of this Court on the basis of matters included or includable in defendant's prior appeal." *Id.* at 337.

Technograph seeks to distinguish *Seese* on the ground that the supervening Federal Circuit decisions, *see supra* note 2, were not "matters included or includable" in its prior appeal because they were rendered after the Third Circuit decision on the non-bumper parts issue. The Court rejects this argument and finds *Seese* controlling. Although the 1983 Federal Circuit decisions could not have been brought up to the Third Circuit in 1981, they were included in one of plaintiff's prior appeals—the 1985 certiorari petition on which the Supreme Court denied review.[5] Plaintiff's invocation of Rule 60(b)(6) to seek review of the Third Circuit's "error" is improper. *See Eutectic Corp. v. Metco, Inc.*, 597 F.2d 32, 34 (2d Cir. 1979) (rule 60(b)(6) motion cannot be used as substitute for appeal).

In addition, plaintiff admits that determination of the motion is a matter of the court's discretion. The Court will exercise that discretion and deny the motion. Plaintiff has had an abundance of opportunities to make its case for a royalty award on non-bumper parts—before the Special Master, this Court, the Third Circuit, the Supreme Court in 1982 and the Supreme Court in 1985—and the issue consistently has been determined against it. This

[5] *Standard Oil Co. v. United States*, 429 U.S. 17 (1976) (per curiam) is distinguishable for the same reason. *See Seese*, 679 F.2d at 337 n.1.

Court will reconsider the matter only if directed to do so by a higher court.

II. ADDITIONAL POSTJUDGMENT INTEREST

On August 22, 1983, this Court issued an opinion requiring G.M. to pay postjudgment interest on the damage award at the rate of sixteen percent per annum, 569 F.Supp. 1354. On August 30, 1983, G.M. paid into court $7,170,344.39, representing the full amount of postjudgment interest, at sixteen percent, to that date. On September 9, 1983, this Court entered an Order awarding postjudgment interest at sixteen percent against G.M. in the amount of $7,170,344.39, of which $2,688,879.15 was transferred immediately to Technograph. Docket No. 724.[6] The $2.6 million represented interest at six percent per annum, which G.M. admitted it owed; the remaining $4,481,465.24 represented interest at ten percent per annum (the difference between six and sixteen percent), which G.M. disputed it owed to Technograph. The Court did not permit distribution of the $4.4 million at that time to prevent its possible dissipation by Technograph before final appellate determination of the appropriate rate of interest (six percent vs. sixteen percent). *See* Transcript of September 7, 1983, Hearing ("Transcript"), at 2, 12, 13, Docket No. 725.

On December 1, 1983, this Court ordered G.M. to pay $71,262.43 to Technograph as sixteen percent interest on the allowed costs, 577 F.Supp. 429. That amount also was deposited in Court but not released to plaintiff, *see* Docket No. 762, because G.M. claimed that no interest should be awarded on costs. The $4.4 million in postjudgment interest and $71,262.43 in interest on costs ("the funds")

[6] Approximately $484,000 of the $2.6 million also was withheld by the Court because its ownership was disputed among the plaintiffs. Technograph later received this money with accrued interest. *See* Docket No. 773.

were deposited in an account in the name of the "Clerk of the Court of the U.S. District Court for the District of Delaware, C.A. No. 3058", to be invested in insured money market accounts or U.S. Treasury bills, at the direction of plaintiff. *See* Docket No. 717. The funds accrued interest at the market rate, which was less than sixteen percent.

The Third Circuit on November 28, 1984, affirmed this Court's award of sixteen percent postjudgment interest and award of interest on costs, 749 F.2d 1020, 1026-27. This Court approved a stipulation on November 15, 1985, allowing distribution of the $4.4 million and $71,262.43 (plus accrued interest) to Technograph.

Technograph now seeks to recover additional money from G.M. representing the difference between the market-rate interest earned on the funds and the sixteen percent rate of interest awarded by the Court in its September 9, 1983, and December 1, 1983, Orders. Technograph claims that those orders created liquidated amounts equivalent to a judgment, which went unpaid because it did not have complete access to the funds. Postjudgment interest at sixteen percent therefore accrued on the funds until Technograph finally received them November 15, 1985. In addition, Technograph argues that the November 15, 1985, payment must be applied first to accrued interest and then to principal under the "United States" rule, so that a portion of the principal (approximately $660,000) remains unpaid and still is accruing interest at sixteen percent.

Resolution of this matter turns on how G.M.'s payment of the funds into Court is construed. G.M. argues that its payments were made, in effect, under Fed.R.Civ.P. 67, so that its obligation to pay additional interest was dis-

charged.[7] Plaintiff claims that G.M.'s payment was intended as a supersedeas bond under Fed.R.Civ.P. 62(d).[8] No motion under either rule was filed, and this Court's Orders of September 9, 1983, and December 16, 1983, do not specify why the funds were not paid directly to plaintiff. At the September 1983 hearing on the payment, G.M. withdrew its request that the judgment on postjudgment interest be marked satisfied in response to plaintiff's opposition. Transcript at 24.

G.M.'s payments into court served as actual payment of the postjudgment interest judgment, rather than as a supersedeas bond for a stay pending appeal. G.M. paid the funds (representing all postjudgment interest and interest on costs owed) into court, and this Court accepted them, with the understanding that the payments extinguished G.M.'s obligation to pay postjudgment interest and interest on costs. This Court determined that G.M. was liable to the plaintiff, required that payment be made, and ordered that the funds be deposited in a bank account set up in the name of the Clerk of the Court. G.M. had no control over the funds once they were paid into court. Technograph controlled how the funds were invested, and the Court controlled distributions from the account. *See* Docket No.

---

[7] Rule 67 provides:

> In an action in which any part of the relief sought is a judgment for a sum of money . . . , a party, upon notice to every other party, and by leave of court, may deposit with the court all or any part of such sum or thing, whether or not that party claims all or any part of the sum or thing . . . . The fund shall be deposited in an interest-bearing account or invested in an interest-bearing instrument approved by the court.

[8] That provision states: "When an appeal is taken the appellant by giving a supersedeas bond may obtain a stay . . . . The bond may be given at or after the time of filing the notice of appeal or of procuring the order allowing the appeal, as the case may be."

717. G.M. owes no additional postjudgment interest or interest on costs. *Cf. International Telemeter Corp. v. Hamlin Int'l Corp.*, 754 F.2d 1492, 1495 (9th Cir. 1985) (postjudgment interest at statutory rate owed on funds in escrow account established by agreement of parties, over which debtor retained investment control); *Reliable Marine Boiler Repair, Inc. v. Mastan Co.*, 325 F.Supp. 58, 64 (S.D.N.Y. 1971) (plaintiff not entitled to interest on funds in possession of court).[9]

For the foregoing reasons, the Court denies plaintiff's Motion for an Award of Interest and for a Reasonable Royalty Award on Non-Bumper Parts. An Order will enter in conformity with this Opinion.

---

[9] The actions of G.M. also suggest that it did not intend the $4.4 million payment to serve as as supersedeas bond. It paid the money before it filed an appeal and even before it was ordered to pay. Rule 62(d) requires that the bond be given "at or after" the time of filing the notice of appeal. G.M.'s counsel also stated that its payment provided plaintiffs with "much more protection than they would have by a supersedeas bond . . . ." Transcript at 2, indicating that the payment was intended as something other than a supersedeas bond. This Court would not have required G.M. to provide a supersedeas bond because of the company's vast assets.

United States v. Los Angeles Soap Co., 153 F.2d 320 (9th Cir. 1946), on which plaintiff relies, is distinguishable. The monies paid into court there were designated by the court as "security" for the disputed tax liability, 153 F.2d at 321. This Court did not designate G.M.'s payments as security for anything, nor intend them to serve as such.

Appendix G

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

DEVEX CORPORATION, et al.,
Plaintiffs,
v. Civil Action 3058 CMW

GENERAL MOTORS CORPORATION,
Defendant.

CONSOLIDATED

FREDERICK B. ZIESENHEIM, et al.,
Plaintiffs,
v. Civil Action 83-567 CMW

TECHNOGRAPH, INC.,
Defendant.

ORDER

This 27th day of June 1986, for the reasons stated in the accompanying Opinion,

IT IS HEREBY ORDERED that Technograph's Motion for Award of Interest and for Reconsideration of Judgment with respect to Non-Bumper Parts is denied.

/s/ Caleb M. Wright
UNITED STATES DISTRICT CT. JUDGE

Appendix H

IN THE UNITED STATES COURT,

For the Northern District of Illinois

Civil Action No.....

Devex Corporation, a Corporation of Ohio; William C. McCoy, 524 Bulkley Building, Cleveland 15, Ohio; and Theodore A. TeGrotenhuis, 524 Bulkley Building, Cleveland 15, Ohio.

Plaintiffs,

vs.

General Motors Corporation, a Corporation of Delaware; and Metal Lubricants Co., a Corporation of Illinois,

Defendants.

56 C 1912
(For Infringement of United States Patent
Letters Patent Reissue No. 24,017).

COMPLAINT

The Plaintiffs, complaining of the Defendants, allege:

I.

This is a civil action for patent infringement. The jurisdiction of the Court in this action arises under the Patent Laws of the United States.

II.

Plaintiff Devex Corporation is an Ohio Corporation, with its principal office at 1296 Hall Avenue, Lakewood 7, Ohio; Plaintiffs William C. McCoy and Theodore A. TeGrotenhuis are citizens of the State of Ohio, with offices at 524 Bulkley Building, Cleveland 15, County of Cuyahoga and State of Ohio.

Appendix H

III.

The Defendant General Motors Corporation is a corporation organized and existing under the laws of the State of Delaware, and it is domesticated in Illinois and qualified as a foreign corporation to do business in the State of Illinois. This Defendant has several regular and established places of business in Illinois, including regular and established places of business in the City of Chicago and within the Northern District of the State of Illinois; and this Defendant has committed acts of infringement herein complained of in the Northern District of Illinois as well as elsewhere in the United States.

IV.

The Defendant Metal Lubricants Co. is a corporation organized and existing under the laws of the State of Illinois, and it has a regular and established place of business at 3211 South Wood Street, Chicago 8, Illinois. This Defendant has committed acts of infringement herein complained of in the Northern District of Illinois.

V.

On March 4, 1952, United States Letters Patent No. 2,588,234 were duly and lawfully issued to John A. Henricks of Lakewood, Ohio for an invention in a method of coating and drawing metal. On June 7, 1955, Letters Patent Reissue No. 24,017 were duly and lawfully issued to John A. Henricks for the same invention.

VI.

By an assignment effective as of February 1, 1949, and dated August 22, 1955, the inventor of Letters Patent Reissue No. 24,017, John A. Henricks, assigned said patent to Plaintiff Devex Corporation. By an assignment dated September 10, 1955, Plaintiff Devex Corporation assigned said patent to Plaintiffs William C. McCoy and Theodore A. TeGrotenhuis. Plaintiff Devex Corporation,

however, retained certain reversionary rights therein which it now has.

VII.

Except for certain rights retained by Plaintiff Devex Corporation, Plaintiffs William C. McCoy and Theodore A. TeGrotenhuis are the owners of Letters Patent Reissue No. 24,017.

VIII.

The Defendant, General Motors Corporation, has infringed and is continuing to infringe the Letters Patent Reissue No. 24,017 by drawing and deforming metal according to the process described and claimed therein. Defendant General Motors Corporation has been fully informed with regards to said patent and its infringement thereof, but has nevertheless continued to infringe the same.

IX.

The Defendant, Metals Lubricants Co., has promoted the infringement of Letters Patent Reissue No. 24,017 by Defendant General Motors Corporation by agreeing to hold Defendant General Motors Corporation harmless from any patent liability that may be involved in its use of the process claimed and described in said patent. Defendant Metal Lubricants Co. has been informed with regards to said patent.

X.

By reason of the infringement of the Defendants, Plaintiffs have been seriously damaged and injured.

Wherefore, Plaintiffs pray:

(a) For an accounting to establish their damages against each Defendant; that the damages so found be trebled; and

for judgment against the Defendants according to their respective liabilities;

(b) For reasonable attorneys' fees unjustifiably caused them;

(c) For an assessment of costs against each of the Defendants; and

(d) For such other and further relief as may be required and appropriate in the premises.

Devex Corporation
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Theodore A. TeGrotenhuis,
By /s/ Frank H. Marks
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Supreme Court, U.S.
FILED
JAN 16 1987
JOSEPH F. SPANIOL, JR.
CLERK

No. 86-1004

IN THE

Supreme Court of the United States

OCTOBER TERM, 1986

TECHNOGRAPH LIQUIDATING TRUST,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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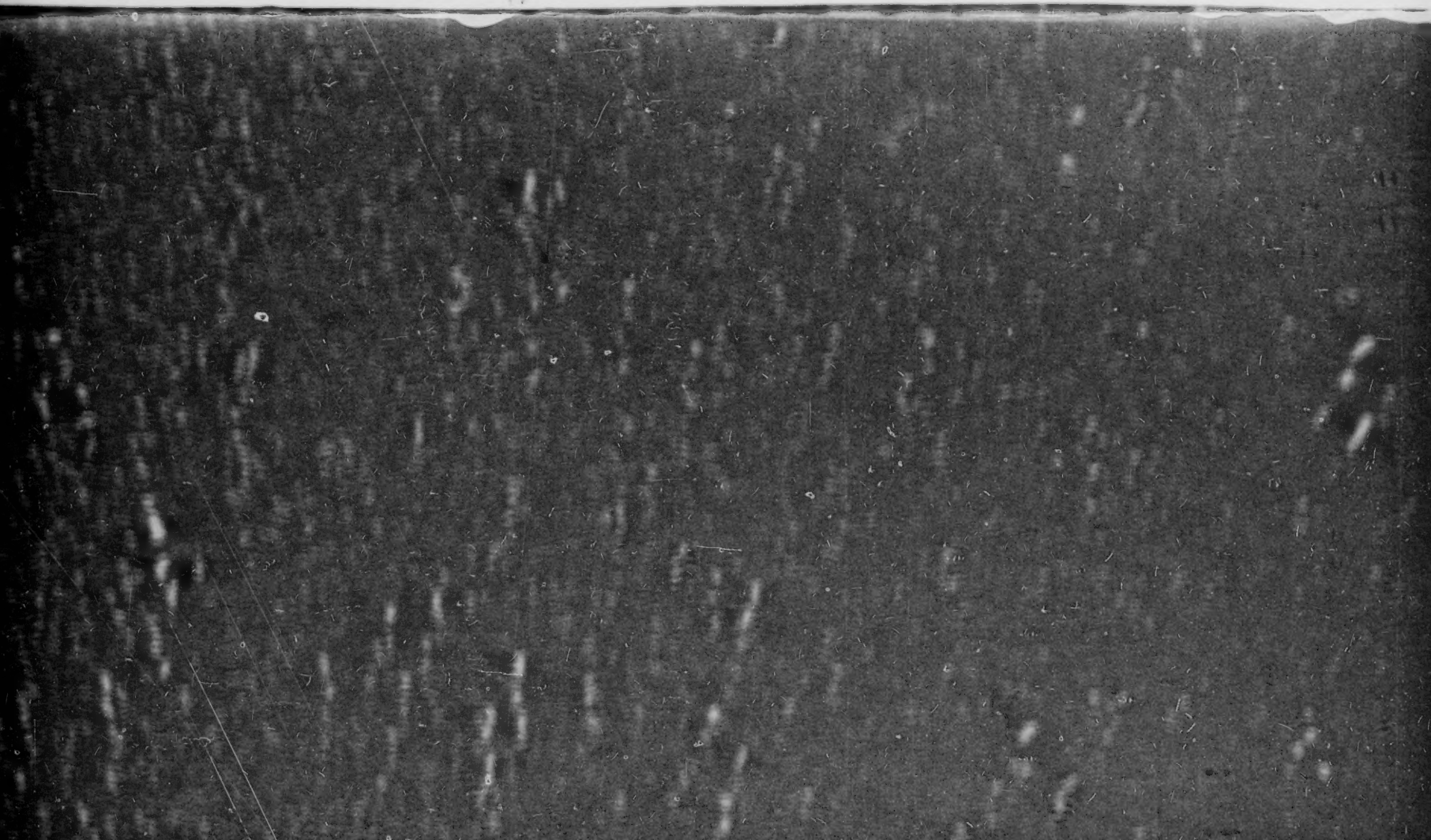

QUESTIONS PRESENTED
(Affirmatively Stated)

1. The decision below will not affect anyone other than the parties to this thirty year old lawsuit. Even incorrectly assuming that this litigation still contains issues arising under the patent statutes, a decision on the jurisdictional question of whether the appeal should be heard by the U.S. Court of Appeals for the Federal Circuit or the U.S. Court of Appeals for the Third Circuit deals with a vanishing (or vanished) type of case, i.e., patent litigation where an appeal was taken to a regional court of appeals prior to the 1982 establishment of the Federal Circuit, where there was a remand for further proceedings and then another appeal was filed after the 1982 establishment of the Federal Circuit. The facts of this case do not lend themselves to a definitive ruling by the U.S. Supreme Court establishing bright line boundaries for the jurisdiction of the Federal Circuit. Thus, the issues raised in the Petition are of no public importance and the Petition should be denied. *See*, *Rice v. Sioux City Cemetery*, 349 U.S. 70, 79 (1955).

2. The subject of the Petition for Certiorari is an interlocutory transfer order. Consequently, in addition to the normally heavy burden which must be met to obtain the grant of a certiorari petition, petitioner has a still further burden of showing truly extraordinary circumstances justifying certiorari on a non-final order. *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 258 (1916); *Brotherhood of Locomotive Firemen v. Bangor & Aroostock R. Co.*, 389 U.S. 327, 328 (1967). That burden has not even been approached here.

3. The Federal Circuit was correct in transferring the appeal to the Third Circuit pursuant to 28 U.S.C. §1631 because there was no jurisdiction in the Federal Circuit, all patent issues in the litigation having been finally adjudicated years ago. Also, as required by § 1631, it was in the interest of justice to transfer the case to the Third Circuit because the Third Circuit has already decided three previous appeals in this litigation involving patent and non-patent issues.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1986

No. 86-1004

TECHNOGRAPH LIQUIDATING, TRUST,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

OPINIONS BELOW, JURISDICTION, AND STATUTES INVOLVED

General Motors agrees with petitioner's recitation of the Opinions below, the jurisdiction of this Court and the statutes involved, except that General Motors disagrees with petitioner's interpretation of some of these statutes and its suggestion that there continue to be any issues arising under the patent statutes in this lawsuit (Petition, pp. 1, 3).

STATEMENT OF THE CASE

Petitioner's present appeal from the latest decision of the U.S. District Court for the District of Delaware

was filed in the U.S. Court of Appeals for the Federal Circuit, and General Motors' motion under 28 U.S.C. §1631 to transfer the appeal to the U.S. Court of Appeals for the Third Circuit was granted by the Federal Circuit. Petitioner's motion in the Federal Circuit for reargument of the transfer motion and its suggestion that the motion be reheard en banc were each denied. Petitioner's motion in the Third Circuit seeking transfer back to the Federal Circuit was also denied. (Appendices A-E to the Petition).

The subject matter of petitioner's appeal from the District Court deals with (1) the non-patent issue of whether petitioner is entitled to additional interest on post-judgment interest paid into Court by General Motors and (2) reconsideration of the already finally adjudicated question of whether petitioner was entitled to damages relating to General Motors' production of non-bumper parts.

The U.S. Court of Appeals for the Third Circuit has already heard and decided the following three appeals from the U.S. District Court for the District of Delaware in this thirty year old litigation:

1. *Devex Corp. v. General Motors Corp.*, 467 F.2d 257 (3d Cir. 1972), *cert. denied*, 411 U.S. 973 (1973) ruled on patent infringement issues.

2. *Devex Corp. v. General Motors Corp.*, 667 F.2d 347 (3d Cir. 1981) affirmed the District Court's "Final Judgment" awarding over $8.8 million for bumper part infringements, over $11 million in prejudgment interest and denying damages relating to non-bumper parts. Certiorari was granted on the prejudgment interest issue and the Third Circuit's decision was affirmed by this Court, *General Motors Corp v. Devex*

Corp., 461 U.S. 648 (1983). Certiorari was denied the present petitioner on the non-bumper parts damages issue, 456 U.S. 988 (1982).

3. *Devex Corp. v. General Motors Corp.*, 749 F.2d 1020 (3d Cir. 1984) affirmed a ruling awarding petitioner over $7 million in post-judgment interest and interest on costs and denying petitioner compound interest on the post-judgment interest. This appeal was decided by the Third Circuit even though the Federal Circuit was in existence at the time the appeal was filed. Petitioner concedes that the Third Circuit had jurisdiction over this appeal because "[t]here were no patent law issues involved in that appeal" (Petition, p. 4). Certiorari was denied on petitioner's attempt to obtain compound interest on post-judgment interest and also on petitioner's attempt to reopen the issue of damages for non-bumper parts infringement, ___U.S. ___, 106 S.Ct. 68 (1985). In addition to the petition for certiorari, petitioner also filed a "Motion for Leave to File Out-of-Time Petition for Rehearing" on the non-bumper parts damages issue. This was also denied. 54 USLW 3228 (October 7, 1985).

Early in 1986, petitioner filed a motion in the U.S. District Court for the District of Delaware seeking additional interest on the post-judgment interest judgment and the interest on cost judgment General Motors had paid into the District Court in 1983, pending the appeal on these matters to the Third Circuit. Since the District Court still supposedly had this tag-end interest issue before it, petitioner also suggested that the District Court had the power to re-examine the long-since finally decided non-bumper parts damages issue. Petitioner's motions were denied by the District

Court on June 27, 1986. The District Court noted in its Opinion that this litigation "threatens to outlast all human participants" (Appendix F to the Petition; p. 8a).

As noted, petitioner appealed to the U.S. Court of Appeals for the Federal Circuit and General Motors' motion under 28 U.S.C. §1631 to transfer to the Third Circuit was granted. Petitioner's motion for reargument and suggestion that the motion be reheard en banc were each denied as was petitioner's motion in the Third Circuit to transfer the case back to the Federal Circuit.

REASONS FOR DENYING THE WRIT

1.

The transfer by the Federal Circuit to the Third Circuit and the Third Circuit's refusal to transfer the case back to the Federal Circuit affects no one but the parties to this lawsuit and will not serve as precedent for future cases. The Third Circuit decided two appeals in this case prior to 1982 dealing with infringement, damages and prejudgment interest. One of these appeals included the non-bumper parts damages issue. The Third Circuit also heard an appeal in 1984 dealing with post-judgment interest. Since October 1982, the Federal Circuit has had jurisdiction over appeals in cases from federal district courts involving continuing issues of patent law. The factual situation in this case where appeals were heard on patent issues by a regional court of appeals prior to 1982 and still further appeals are filed after 1982 is unlikely to occur again as we move further in time from 1982.

The facts of this case do not present the Supreme Court with an opportunity to draw a clear line for future cases between the jurisdiction of the Federal Circuit and the jurisdiction of the regional courts of appeal. The issues raised in the Petition are of no public importance and do not warrant review by the Supreme Court. *See Rice v. Sioux City Cemetery*, 349 U.S. 70 (1955).

2.

The subject of the Petition for Certiorari is an interlocutory transfer order. Thus, in addition to the normally heavy burden which must be met to obtain the grant of a certiorari petition, petitioner has a still further burden of showing truly extraordinary circumstances justifying certiorari on a non-final order. *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 258 (1916); *Brotherhood of Locomotive Firemen v. Bangor & Aroostock R. Co.*, 389 U.S. 327, 328 (1967). That burden has not even been approached here.

3.

As stated above, whether right or wrong, the rulings of both the Federal Circuit and Third Circuit that the appeal should be decided by the Third Circuit do not deal with issues worthy of certiorari. The fact is, however, that the decisions by the Federal Circuit and the Third Circuit are clearly correct, for the reasons which follow, and nothing would be served by the grant of a petition for certiorari in this case.

a. No unadjudicated issues arising under the patent statutes remain in this case, since all patent issues were finally adjudicated years ago. While the case

contained substantial patent issues for a long time, there are none now present. The Third Circuit decided the non-bumper parts damages issue in 1981 and certiorari thereon was denied in 1982. Certiorari was again denied on the same issue in 1985 as was a "Petition for Leave to File Out-of-Time Petition for Rehearing" on the earlier denial of certiorari.

The Federal Circuit has no jurisdiction over appeals if issues arising under the patent statutes are no longer in the case or if such issues are trivial or frivolous or immaterial. *USM Corporation v. SPS Technologies, Inc.*, 770 F.2d 1035 (Fed.Cir. 1985); *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422 (Fed.Cir. 1984); 1982 *U.S. Code Cong. & Adm. News*, pp. 11, 29, 30.

In *USM Corporation, Id.* at 1037, the appeal was properly transferred from the Federal Circuit to the Seventh Circuit because "all patent claims had been finally adjudicated well in advance of the issue presently on appeal." The non-bumper parts damages issue which was in the instant case is not by any realistic standard continuing, and its attempted revisiting after final determination years ago is trivial, frivolous and immaterial. The other issue on appeal is a post-judgment interest question which even petitioner does not contend has anything to do with patents (Petition, pp. 5, 8).

Petitioner criticizes the Federal Circuit for transferring this case to the Third Circuit in the interest of judicial efficiency when 28 U.S.C. §1631 speaks of transferring where there is a "want of jurisdiction, . . . if it is in the interest of justice . . ." (Petition, p. 10). The Federal Circuit, having dealt with 28 U.S.C. §1631 many times, is obviously aware of its

requirements. What the Federal Circuit did here in its less than two page Order is the same thing it did in *USM Corporation, Id.* (which was cited in the two-page Order), where it spelled out its lack of jurisdiction in an opinion.

In *USM Corporation, Id.*, the Federal Circuit phrased the issue quite properly to be whether it had jurisdiction (770 F.2d at 1036):

> This appeal raises the question of our jurisdiction over an appeal where the Seventh Circuit has finally adjudicated all patent issues and only non-patent issues remain, in a case where the jurisdiction of the district court was originally based, in part, upon 28 U.S.C. §1338(a). (emphasis added).

This question was appropriately resolved, as here, by considering judicial efficiency (770 F.2d at 1037):

> Policies of judicial efficiency favor transferring the appeal to the Seventh Circuit. This case has already been before the Seventh Circuit twice on appeal with many of the underlying issues fully briefed by the parties to that court.

What petitioner is attempting here would decimate the law established in *USM Corporation*, 770 F.2d 1035 and the purpose for which the Federal Circuit was established. The plaintiff in *USM Corporation* could also have suggested that once any aspect of a case remains open—no matter how tag-end, minor or severable—everything that occurred in the case from its beginning is fair game for reconsideration. Such a suggestion, however, is impractical, illogical and contrary to existing law.

The Federal Circuit in *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422 (Fed.Cir. 1984) correctly made it clear that in appropriate situations it could rule it had no jurisdiction based on considerations such as judicial efficiency (*Id.* at 1428, 1429):

> The present motion enables the court, with the appreciated cooperation of ten *amici*, to respond in part to Congress' expectation that it would formulate appropriate standards for determining jurisdiction.
>
> * * *
>
> That this court upholds its jurisdiction here does not preclude a contrary holding in future, different cases. Nor does it preclude transfer under 28 U.S.C. §1631 of an appeal so devoid of patent issues, present or potential, as to suggest transfer. Federal courts have declined jurisdiction over pendent and ancillary claims in the interest of "judicial economy, convenience, and fairness to litigants." *United Mine Workers of America v. Gibbs*, 383 U.S. 715, 726, 86 S.Ct. 1130, 1139, 16 L.Ed.2d 218 (1966). (emphasis added).

b. Petitioner's citations are not in point:

i. In *Central Soya Co. Inc. v. Geo. A. Hormel & Co.*, 723 F.2d 1573 (Fed.Cir. 1983) (Petition, pp. 7, 8) the Tenth Circuit heard the appeal from the District Court's patent liability ruling but the appeal from the subsequent patent accounting trial was properly directed to the then newly created Federal Circuit. In *Central Soya*, contrary to this case, there had not been a final adjudication of all issues arising under

the patent statutes, so the post 1982 appeal clearly belonged in the Federal Circuit. In the present case, petitioner went into the District Court on a tag-end general law issue of whether it was entitled to additional interest on money previously deposited in the District Court to satisfy a judgment. Petitioner added to this issue a piggy-back motion for reconsideration of the long-ago finally adjudicated non-bumper patent issue. This transparent attempt to resurrect a spurious patent issue which is incapable of resurrection does not transfer to the Federal Circuit exclusive jurisdiction over the appeal from the Third Circuit which has already finally decided three appeals in this case.

ii. *Albert v. Kevex Corp.*, 729 F.2d 575 (Fed.Cir. 1984) (Petition, p. 7) is of no help to petitioner because there, "two patent infringement counts remained to be adjudicated in district court." All patent counts in the instant case were finally decided years ago.

iii. Petitioner's reliance (Petition, pp. 8, 9) on the Seventh Circuit's ruling in *Christianson v. Colt Industries Operating Corp.*, 798 F.2d 1051 (7th Cir. 1986) is also misplaced. Colt had been sued under the antitrust laws in a Complaint which the Seventh Circuit felt necessarily included within its scope important patent issues. The linchpin of the District Court's 1984 ruling being appealed was that nine patents of Colt did not meet the "best mode" requirements of 35 U.S.C. §112 so they "were invalid ab initio." There had never "been a prior plenary appellate decision on the merits." Consequently, the Seventh Circuit was of the opinion that the appeal included many still existing substantial issues which "arose under" the

patent laws which should be decided by the Federal Circuit (*Id.* at 1062).

The *Christianson v. Colt* situation is in stark contrast to our case in which all patent issues have been finally adjudicated. Also, in *Christianson v. Colt*, there was a dispute between the Federal Circuit and the Seventh Circuit as to which Court had jurisdiction over the appeal. In the instant case, the Federal Circuit and the Third Circuit are in complete agreement that the appeal should be in the Third Circuit.

If *Christianson v. Colt* (argued in the Federal Circuit on October 6, 1986 and not yet decided) is going to sow the seeds for "endless disputes" (Petition, pp. 9, 10) between the Federal Circuit and other federal courts of appeal regarding jurisdiction over some appeals, that is perhaps the case for certiorari. The present case is thirty years old and is too exhausted to sow any seeds.

CONCLUSION

For the reasons stated above, the Petition should be denied.

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No. 86-1004

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1986

TECHNOGRAPH LIQUIDATING TRUST,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

REPLY BRIEF OF PETITIONER, TECHNOGRAPH LIQUIDATING TRUST

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1986

TECHNOGRAPH LIQUIDATING TRUST,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

REPLY BRIEF OF PETITIONER, TECHNOGRAPH LIQUIDATING TRUST

Summary of Argument

1. Respondent cannot and does not dispute petitioner's primary position that the explicit statutory language of 28 U.S.C. sec. 1295(a)(1) vests exclusive jurisdiction of the appeal in the Federal Circuit where the district court's jurisdiction was, as here, based in whole or in part upon the patent code. This Court should now enforce that congressional mandate by directing the lower courts to follow precisely that straightforward legal standard and to avoid added criteria.

2. Assuming *arguendo* that the Federal Circuit has exclusive jurisdiction only where there is a substantial patent issue on appeal, petitioner fully satisfies that requirement. Here, the lower courts failed to award any royalty whatsoever on non-bumper parts even though they found that 1.3 billion non-bumper parts infringed, and even though the patent code (35 U.S.C. sec. 284) mandates damages "*in no event* less than a reasonable royalty" once a patent is held valid and infringed. The Third Circuit, on the accounting, held that the award of *no royalty* whatsoever on 1.3 billion non-bumper parts found to be infringing *does* comply with the patent statute. *Devex Corp. v. General Motors Corp.*, 667 F.2d 347, 363 (3d Cir. 1981), *cert. denied in part and granted in part*, 456 U.S. 988 (1982).

Reconsideration of this erroneous holding is proper because supervening "controlling authority [of the Federal Circuit] has since made a contrary decision of the law applicable to such issues," *Central Soya Co., Inc. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1580 (Fed. Cir. 1983): in *Stickle v. Heublein, Inc.*, 716 F.2d 1550, 1561 (Fed. Cir. 1983) (interpreting sec. 284), the Federal Circuit clearly stated that once infringement is found an award of no royalty is "contrary to the express statutory provision."

3. GM implicitly acknowledges that where there are issues "still present based on the patent statutes," exclusive jurisdiction is vested in the Federal Circuit (GMB 86-1179, 9).[1] Petitioner has demonstrated that substantial patent issues are, in fact, presented on the appeal. Thus, GM's characterization of the patent issues—namely failure to award any royalty whatsoever based on 1.3 billion parts found to have infringed—as "trivial, frivolous and immaterial" (*id.*) is plainly untenable. The Federal Circuit did not find an absence of patent issues on the appeal. Significantly, GM makes no argument to the contrary.

Moreover, GM concedes that the Federal Circuit's reconsideration of the Tenth Circuit's holding on liability in a patent case under the law of the case doctrine is within the jurisdiction of the Federal Circuit and, thus, constitutes a patent issue. (*Id.*, 12). *A fortiorari* reconsideration of a "damage" issue in a patent case, as here, is likewise a patent issue on appeal.

4. Judicial efficiency requires that the jurisdictional uncertainty surrounding 28 U.S.C. sec. 1295(a)(1), compounded by the order below, be remedied forthwith. As the Seventh Circuit

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[1] References to Technograph's Petitions for a Writ of Certiorari, Docket Nos. 86-1004 and 86-1179, are referred to as "P 86-1004, ___" and "P 86-1179, ___", respectively, including page number. References to General Motors' Briefs in Opposition to Petition for Certiorari, Dockets Nos. 86-1004 and 86-1179, are referred to as "GMB 86-1004, ___" and "GMB 86-1179, ___" respectively, including page numbers. Emphasis supplied throughout unless otherwise noted.

recently stated, "[t]he instant appeal is but another in the burgeoning list of cases delineating at considerable expense to the parties and *the judicial system* . . . the boundaries of 28 U.S.C. sec. 1295(a)(1)." *Christianson v. Colt Industries Operating Corp.*, 798 F.2d 1051, 1058 n. 10 (7th Cir. 1986).

RE QUESTION NO. 1

This case presents an excellent opportunity for this Court to render a definitive ruling establishing the bright line boundaries of the jurisdiction of the Federal Circuit in accordance with the explicit statutory language of 28 U.S.C. sec. 1295(a)(1) since the case indisputably arose under 28 U.S.C. sec. 1338 and there is a substantial patent question on appeal.

The Federal Courts Improvement Act of 1982 provides that the Federal Circuit shall have "exclusive jurisdiction of an appeal from a final decision of a district court—if the jurisdiction of the court was based, in whole or in part, on section 1338 of this title (the jurisdictional statute covering civil patent suits)." 28 U.S.C. sec. 1295(a)(1). The facts of this case—(1) the jurisdiction of the district court under 28 U.S.C. sec. 1338 and (2) the substantial patent question on appeal—squarely call for a ruling by this Court establishing the bright line boundaries of the Federal Circuit's jurisdiction. Specifically, this petition contains "special and important reasons" for granting the writ, Sup. Ct. R. 17.1, since the questions presented involve the proper interpretation of a statute which explicitly vests "exclusive jurisdiction" in the Federal Circuit. A definitive ruling from this Court will have important beneficial ramifications by eliminating time consuming jurisdictional uncertainty regarding 28 U.S.C. sec. 1295(a)(1) in future cases.[2]

[2] By contrast, *Rice v. Sioux City Memorial Park Cemetery, Inc.*, 349 U.S. 70 (1955) (cited by Respondent, GMB 86-1004, i; GMB 86-1179, ii) in which the Supreme Court dismissed a writ of certiorari as improvidently granted, involved a case of truly "isolated significance". A state statute which prohibited cemeteries from denying burial on account of race or color had been enacted

(*footnote continued on following page*)

The statute gives the Federal Circuit exclusive jurisdiction of patent appeals after October 1, 1982, and its interpretation is not influenced by the prior history of the current litigation.

28 U.S.C. 1295(a)(1) affirmatively states the exclusive jurisdiction of the Federal Circuit in specific circumstances. The exclusiveness feature cannot be "read . . . out of" the statute. *Hohri v. United States,* 782 F.2d 227, 240, 258 (D.C. Cir.), *cert. granted,* 55 U.S.L.W. 3348 (1986). In *Hohri,* both the majority and the minority agreed on this proposition. *Id.* As stated in the legislative history, "an adequate showing has been made for nationwide subject matter jurisdiction in the areas of patent . . . appeals." Sen. R. at 4, 1982 U.S. Code Cong. & Ad. News, 14.

Nothing in the statute even remotely suggests that the exclusive jurisdiction of the Federal Circuit is influenced by the prior history of the current litigation or by another court's familiarity with the case.[3] Any such reading is totally inconsistent with the statutory language and, as a matter of policy, this Court should not permit it to stand. Respondent's attempted obfuscation of the issue by its focus on the prior history of the case and its reference to this as a "vanishing type of case"

(*footnote continued from preceding page*)
subsequent to the relevant incident, thus limiting the public importance of plaintiff's suit seeking damages for mental suffering flowing from the cemetery's refusal to bury plaintiff's Indian husband and avoiding the need to resolve the constitutional question whether a racially restrictive covenant would be a defense.

In the petition *sub judice,* all the facts relevant to the Court's determination—the jurisdiction of the district court and the questions on appeal—are as important for future cases as for this case. The irrelevant facts (for jurisdictional purposes), *i.e.,* the prior appeals to the Third Circuit, may be unique to this case, but can in no way affect the interpretation of 28 U.S.C. sec. 1295(a)(1).

[3] "Here we do not base our decision on policy concerns for fairness or efficiency. On the contrary, we take jurisdiction on the basis of our reading of the plain meaning of the statutory language." *Hohri v. United States,* 782 F.2d 227, 240 n. 28 (D.C. Cir.), *cert. granted,* 55 U.S.L.W. 3348 (1986).

(GMB 86-1004, i) is totally without merit since that history is irrelevant to proper interpretation of the statute.

The position advocated in this petition would not subvert the rule established in *USM Corp. v. SPS Technologies, Inc.*, 770 F.2d 1035 (Fed. Cir. 1985). In that case there had been an explicit finding that all patent issues had been finally adjudicated. 770 F.2d at 1037. Here, there can be no such finding. Indeed, in its transfer order the Federal Circuit recognized the presence of the patent law question, but then erroneously transferred the case to the Third Circuit.

Respondent's reliance on the Third Circuit's prior denial of any royalty whatsoever misses our point that application of "the law of the case" doctrine, as well as its exceptions, in a patent case itself presents a substantial patent question. *Central Soya Co., Inc. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1580 (Fed. Cir. 1983).

> This appeal presents unusual circumstances in that the same court is not being asked to reconsider its own prior decision. Rather, we are being asked to review the decision of the Tenth Circuit Court of Appeals in a case over which we have exclusive jurisdiction by virtue of an Act of Congress. In our opinion, the purpose and intent of the law of the case doctrine is fully applicable to this transitory situation, and all interests will be served by adherence to it . . . . While the law of the case doctrine is applicable, and acts as "a heavy deterrent to vacillation on arguable issues," it is not an inexorable command, and should be applied "as a matter of sound judicial practice, under which a court generally adheres to a decision in a prior appeal in the case unless one of three 'exceptional circumstances' exists: 'the evidence on a subsequent trial was substantially different, controlling authority has since made a contrary decision of the law applicable to such issues, or the decision was clearly erroneous and would work a manifest injustice.' "

Id. (citations omitted).

Further, to the extent that the merits of this litigation are now before the Court, the failure of the district court to award any royalty after finding infringement of 1.3 billion non-bumper parts in the face of a statute which explicitly provides that the awarded damages shall be *"in no event less than a reasonable royalty"*, 35 U.S.C. sec. 284, amounts to a travesty of justice. Moreover, the contrary supervening decisions by the Federal Circuit highlight the importance of reconsidering that erroneous holding.

Once infringement is found, an award of no royalty is "contrary to the express statutory provision." *Stickle v. Heublein, Inc.*, 716 F.2d 1550, 1561 (Fed. Cir. 1983) (interpreting sec. 284). Specifically, upon a finding of infringement, the District Court has *"no alternative* but that of measuring damages by what would have been a reasonable royalty." *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1520 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984). The Federal Circuit rejected the result that "no damages would be awardable" upon a finding of infringement. *Stickle v. Heublein, Inc., supra; Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1078 (Fed. Cir. 1983). Thus, under supervening decisions of the Federal Circuit, the District Court, upon findings of validity and infringement, *"must"* (but failed to) determine a reasonable royalty.

Congress in the 1946 patent statute provided for damages in an amount *"not less* than a reasonable royalty." In 1952, Congress deliberately changed "not" to *"in no event"* less than a reasonable royalty. "In no event," means "in no case" or "in no circumstance." No exceptions are stated to this explicit mandate. Since a reasonable royalty is based on a court-created fiction of a hypothetical negotiation between a willing buyer and a willing seller, who would obviously never agree to a zero royalty, there can never be a failure of proof with respect to a reasonable royalty. *See Sel-O-Rak Corp. v. Henry Hanger & Display Fixture Corp.*, 159 F. Supp. 769, 776 (S.D. Fla. 1958), *aff'd*, 270 F.2d 635 (5th Cir. 1959). This concept was grasped by the Federal Circuit in the supervening decisions upon which we rely in contradiction of the decision in the District Court and in the Third Circuit.

The fact that the litigation has extended over thirty years—during which time plaintiff proved its patent valid, proved infringement, yet collected no royalty for non-bumper parts—dramatizes the gross injustice. It does not lie in the mouth of defendant who has deprived plaintiff of its monies for thirty years, to complain of exhaustion (GMB 86-1004, 10; GMB 86-1179, 14).[4]

This case indisputably presents a petition from a final judgment of the Federal Circuit.

Contrary to respondent's bald assertion that the subject of the petition is an interlocutory order, the Court will note that the Federal Circuit entered *judgment* in connection with its transfer order (P 86-1004, 1a; P 86-1179, 1a). That judgment is indisputably final insofar as the Federal Circuit divested itself of jurisdiction by the judgment.[5]

Respondent's comment that the Federal Circuit and the Third Circuit agree that the appeal should be in the Third Circuit (GMB 86-1004, 10) implies the untenable proposition that the Circuit Courts of Appeal may apportion jurisdiction among themselves by agreement without regard to the mandatory jurisdictional provisions of the statute.

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[4] Significantly, in an effort to save costs and judicial time, plaintiff attempted to resolve the 1986 postjudgment interest issue amicably prior to its motion in the district court. Plaintiff's efforts to secure postjudgment interest certainly cannot be called frivolous. With regard to postjudgment interest on a different issue, Judge Gibbons noted,

> "By allowing General Motors the interest-free use of delinquent payments, the court is depleting plaintiffs' real recovery as surely as if it had simply reduced the amount of their award. It is, moreover, rewarding General Motors for resorting to this court on several occasions in the interest of delay."

Devex Corp. v. General Motors Corp., 749 F.2d 1020, 1028 (3d Cir. 1984) (Gibbons, J. dissent), *cert. denied*, 106 S. Ct. 68 (1985).

[5] Indeed, Respondent implicitly recognizes the weakness of its position, inasmuch as it merely states its conclusion twice, cites two cases presenting totally different circumstances, and fails to argue the point. (GMB 86-1004, i, 5; GMB 86-1179, ii-iii, 7-8).

A clear statement by this Court regarding the exclusive jurisdiction of the Federal Circuit is necessary to remedy the "jurisdictional uncertainty" surrounding 28 U.S.C. sec. 1295(a)(1). *Christianson v. Colt Industries Operating Corp.*, 798 F.2d 1051, 1058 n. 10 (7th Cir. 1986). Contra defendants (GMB 86-1179, 5-6), the Seventh Circuit in *Christianson* recognized the "burgeoning list of cases", *id.*, involving disputes regarding the boundaries of 28 U.S.C. sec. 1295(a)(1). *Christianson* is unique only in the sense that the Seventh Circuit disagreed with the Federal Circuit's transfer order. Other cases amply demonstrate the pervasive uncertainty regarding the Federal Circuit's jurisdiction. *See e.g. Albert v. Kevex Corp.*, 729 F.2d 757 (Fed. Cir. 1984) (exclusive jurisdiction in Federal Circuit on non-patent issues where patent issues remained to be adjudicated); *Chemical Engineeering Corp. v. Marlo, Inc.*, 754 F.2d 331 (Fed. Cir. 1984) (although plaintiff's complaint pleaded jurisdiction on diversity alone, court found that jurisdiction under 28 U.S.C. sec. 1338 inhered in action, *mandating* appeal to Federal Circuit); *Gilson v. Republic of Ireland*, 787 F.2d 655 (D.C. Cir. 1986) (no Federal Circuit jurisdiction since suit for misappropriation of rights under patent license did not arise under 28 U.S.C. sec. 1338).

In order to avoid the judicial waste of time at the court of appeals level resulting from the jurisdictional uncertainties compounded by the judgment below, this Court need only issue a straightforward order re-establishing the Federal Circuit's exclusive jurisdiction as established by congressional mandate.

RE QUESTION NO. 2

28 U.S.C. sec. 1631, which explicitly requires the court of appeals to find "a want of jurisdiction" before entering a transfer order, cannot be circumvented by focusing on judicial efficiency.

28 U.S.C. sec. 1631, captioned "[t]ransfer to cure want of jurisdiction, permits a court to transfer an appeal if "that court finds that there is a want of jurisdiction" in it. As explicitly stated in the text of the statute (and reinforced by the caption)

the finding of a want of jurisdiction is a prerequisite to transfer. *Hempstead County and Nevada County Project v. Environmental Protection Agency*, 700 F.2d 459, 462 (8th Cir. 1983) ("First, the court where the action is originally filed must find that there is a want of jurisdiction;"). Any suggestion that exclusive jurisdiction can be abdicated without such a finding is untenable. Respondent's statement that "as required by sec. 1631, it was in the interest of justice to transfer the case to the Third Circuit" (GMB 86-1004, ii), ignores the fact that the court must *first* find that there is a want of jurisdiction before it may consider whether the interest of justice warrants a transfer.[6]

Respondent mischaracterizes the Federal Circuit's statement in the well-reasoned opinion of *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422 (Fed. Cir. 1984) (GMB 86-1004, 8; GMB 86-1179, 11-12). The statement in *Atari* that courts have declined jurisdiction "over pendent and ancillary claims in the interests of '*judicial economy, convenience, and fairness to litigants*' " was made *only* in connection with said *pendent and ancillary jurisdiction*. *Atari* carries no suggestion that concerns of judicial efficiency may divest a court of *mandatory exclusive* jurisdiction.

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[6] Respondent *sub silentio* admits that the Federal Circuit's transfer order lacked the requisite finding of a want of jurisdiction as it states that what the Federal Circuit did here (where it made no finding of a want of jurisdiction) is the same thing it did in *USM Corp.* "where [the Federal Circuit] spelled out its lack of jurisdiction in an opinion." (GMB 86-1179, 10). A straightforward reading of the two-page order evidences absolutely no mention of a want of jurisdiction.

CONCLUSION

For the reasons stated in the Petition and herein, the Petition for a Writ of Certiorari should be granted.

Respectfully submitted

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